

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 18

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte JOHN T. KREITZER, DAVID F. KREITZER and DAN B. POOL

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Appeal No. 1999-2626  
Application 08/756,060<sup>1</sup>

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ON BRIEF

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Before McQUADE, CRAWFORD and BAHR, Administrative Patent Judges.

McQUADE, Administrative Patent Judge.

DECISION ON APPEAL

John T. Kreitzer et al. appeal from the final rejection of claims 1 through 9 and 15 through 19. Claims 10 through 14, the only other claims pending in the application, stand

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<sup>1</sup> Application for patent filed November 26, 1996.

withdrawn from consideration pursuant to 37 CFR § 1.142(b).

The subject matter on appeal relates to "a nasal dilator for maintaining one or more nasal passages of a nose in a dilated condition" (specification, page 1). Claim 1 is illustrative and reads as follows:<sup>2</sup>

1. A nasal dilator for dilating a first nasal passage and a second nasal passage of a nose, comprising:

a first dilating element engagable to the outer wall of a first nasal passage;

a second dilating element engagable to the outer wall of a second nasal passage;

a bridge element traversing the nose and interconnecting the first dilating member and the second dilating member, the bridge includes an elastic element movable toward an expanded configuration wherein the length of the elastic element increases, and biases to a retracted configuration wherein the length of the elastic element is reduced.

The references relied upon by the examiner in support of the final rejection are:

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<sup>2</sup> Our review of the appealed claims indicates that claim 5 is redundant with respect to parent claim 4 and that the word "each" in the preamble of claim 8 is inconsistent with the rest of the claim. These informalities are deserving of correction in the event of further prosecution before the examiner.

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Johnson <sup>3</sup>	5,533,499	Jul. 9, 1996
Doubek et al. (Doubek)	5,533,503	Jul. 9, 1996

Claims 1 through 9 and 15 through 19 stand rejected under 35 U.S.C. § 102(a) as being anticipated by Doubek.

Claims 1 through 9 and 15 through 19 also stand rejected under 35 U.S.C. § 102(a) as being anticipated by Johnson.

Reference is made to the appellants' main and reply briefs (Paper Nos. 13 and 16) and to the examiner's final rejection and answer (Paper Nos. 9 and 14) for the respective positions of the appellants and the examiner with regard to the merits of these rejections.

Doubek and Johnson disclose similar nasal dilators 10. Each includes first and second planar resilient bands 30a and 30b, first and second flexible adhesive strips 31a and 31b, a flexible strip of base material 18 having a layer of adhesive 46 on its lower surface, and first and second release liners 49 and 50.

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<sup>3</sup> The listing of U.S. Patent No. 5,476,091 to Johnson on page 2 of the examiner's answer (Paper No. 14) as prior art relied upon in the rejection of claims under appeal is erroneous. The final rejection (Paper No. 9) shows that U.S. Patent No. 5,533,499 is the Johnson reference relied upon to reject the claims on appeal.

In use, the Doubek and Johnson dilators are affixed to a nose 12 by the adhesive 46 after removal of the first and second release liners 49 and 50 and assume a curved shape conforming to the contour of the nose. The resiliency and tendency of the first and second resilient bands 30a and 30b to return to their normally planar state provides an outward pull on the outer wall tissues 60 and 62 of the nose to counter the drawing-in forces exerted on the tissues during inhalation (see Doubek at column 7, lines 4 through 10; and Johnson at column 5, lines 13 through 20).

Anticipation is established only when a single prior art reference discloses, expressly or under principles of inherency, each and every element of a claimed invention. RCA Corp. v. Applied Digital Data Sys., Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984).

Independent claims 1 and 6 recite a nasal dilator comprising, inter alia, an "elastic element movable toward an expanded configuration wherein the length of the elastic element increases, and biases to a retracted configuration wherein the length of the elastic element is reduced." Claim 15, the other independent claim on appeal, recites a nasal

dilator comprising, inter alia, an elastic element having first and second ends, with the elastic element being "stretchable toward an expanded configuration wherein the length of the elastic element is increased, and in which configuration the first end and the second end tend to be pulled toward one another so as to tend to reduce the increased length."

In determining that the subject matter recited in the appealed claims is anticipated by either Doubek or Johnson, the examiner has found that the resilient bands 30a and 30b disclosed by each reference meet the foregoing limitations in independent claims 1, 6 and 15 relating to the elastic element. In the examiner's view, because bands 30a and 30b are resilient, they can be lengthened and will return to their original length (see pages 3 and 4 in the answer).

The examiner's position here is unduly speculative. Neither reference gives any express indication that bands 30a and 30b have the elastic length increasing/reducing properties required by a reasonable interpretation of claims 1, 6 and 15.

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Under principles of inherency, when a reference is silent about an asserted inherent characteristic, it must be clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Continental Can Co. v. Monsanto Co., 948 F.2d 1264, 1268, 20 USPQ2d 1746, 1749 (Fed. Cir. 1991). As the court stated in In re Oelrich, 666 F.2d 578, 581, 212 USPQ 323, 326 (CCPA 1981)(quoting Hansgird v. Kemmer, 102 F.2d 212, 214, 40 USPQ 665, 667 (CCPA 1939)):

Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing *may* result from a given set of circumstances is not sufficient. [Citations omitted.] If, however, the disclosure is sufficient to show that the natural result flowing from the operation as taught would result in the performance of the questioned function, it seems to be well settled that the disclosure should be regarded as sufficient.

In the present case, the fact that the beam-like bands 30a and 30b disclosed by Doubek and Johnson have the resiliency to return to their normally planar state after being bent does not necessarily mean that they have the elastic length increasing/decreasing properties at issue. Since neither Doubek nor Johnson discloses any other structure having such

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properties, the examiner's determination that these references disclose each and every element of the invention recited in claims 1, 6 and 15, and in claims 2 through 5, 7 through 9 and 16 through 19 which depend therefrom, is unsound.

Accordingly, we shall not sustain standing 35 U.S.C. § 102(a) rejections of claims 1 through 9 and 15 through 19.

The decision of the examiner is reversed.

REVERSED

JOHN P. McQUADE )  
Administrative Patent Judge )

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PATENT	MURRIEL E. CRAWFORD	) BOARD OF
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	JENNIFER D. BAHR	)
	Administrative Patent Judge	)

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